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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/513,962	02/08/2005	Ulf Forssmann	P67900US1	4706
136 7590 03/07/2007 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			EXAMINER GUDIBANDE, SATYANARAYAN R	
			ART UNIT	PAPER NUMBER
			1654	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
31 DAYS		03/07/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/513,962

Applicant(s)

FORSSMANN ET AL.

Examiner

Satyanarayana R. Gudibande

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 and 18 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

## DETAILED ACTION

### *Oath/Declaration*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application, by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The signature of the inventor Ulf Forssmann is missing in the oath/declaration filed on February 8, 2005. Necessary correction is required.

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I claim 18, drawn to a compound of R1-CCL14[10-74] is a lipophilic, hydrophobic or polar residue.

Group II, claim(s) 1-13, drawn to a method of inhibiting the emigration of cells from the intravascular compartment into tissues by confronting the cells with an agonist specific for receptors involved with migration of said cells via a receptor thereby making the cell unresponsive to further activation.

*Claims 14-17 are use claims and hence drawn to non-statutory subject matter and hence are not be included in any group, because it is not certain what applicants are intending to claim.*

According to PCT Rule 13.2, unity of invention exists only when the shared or corresponding technical feature is a contribution over the prior art. The inventions listed as

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Groups I-II do not relate to a single general inventive concept because they lack the same or corresponding special technical feature. The technical feature of Group I is R1-CCL14 [10-74], which is shown by EP 1 167 527 A1 of Detheux, et al., (page 2, SEQ ID No: 1, line 32). Therefore, the special technical feature of group I is not a contribution over the art and hence lacks unity of invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Election of Species*

Claim 6 is generic to the following disclosed patentably distinct species: chemoattractant. The species are independent or distinct because the chemoattractant is further selected from the group consisting of chemokine, a defensin, a leukotriene, a formyl-peptide or combinations thereof as well as mutants and/or variants of the chemoattractant. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species chemoattractant, even though this requirement is traversed. **Further, if applicant elects chemokine as chemoattractant, applicant is required to specify one single species of chemokine along with the necessary SEQ ID NO., or structure of the compound associated with the elected chemokine species.** Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including

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any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

This application contains claims directed to the following patentably distinct species: R<sup>1</sup>-CCLI4[10-74], R<sup>1</sup>-CXCLI2[I-67], R<sup>1</sup>-CXCLI2V3I[I-67], R<sup>1</sup>-CXCLI212-67], R<sup>1</sup>-CXCLI2V3I[2-67], R<sup>1</sup>-CXCLI2[I-72], R<sup>1</sup>-CXCLI2V3I[I-72], R<sup>1</sup>-CXCLI212-72] and R<sup>1</sup>-CXCLI2V3I[2-72] wherein R<sup>1</sup> is a lipophilic, hydrophobic or polar aprotic residue. The species are independent or distinct because species represent compounds that have distinct chemical structural features.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of the compound wherein the R<sup>1</sup> variable is defined to represent a single structure of the compound claimed in claim 7, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 7-10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

This application contains claims directed to the following patentably distinct species: several species of disease states. The species are independent or distinct because the disease states exhibit distinct etiology and affects different patient population.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of specific disease state for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 11-13 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

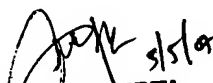
### **Conclusion**

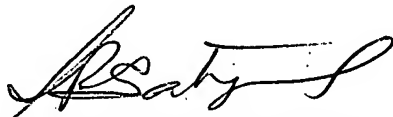
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satyanarayana R. Gudibande whose telephone number is 571-272-8146. The examiner can normally be reached on M-F 8-4.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**ANISH GUPTA**  
**PRIMARY EXAMINER**

  
Satyanarayana R. Gudibande, Ph.D.  
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